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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,549	11/02/2001	Masahiko Hirose	04558.035002	5660

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EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
1723	14

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/002,549

Applicant(s)

HIROSE, MASAHIKO

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/452,731.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 November 2002 has been entered.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. For example, the JP 59-27202 and JP 61-17521, mentioned in applicant's remarks, and listed on page 1 of the specification have not been considered unless they have been in a Notice of References Cited. It is further noted that, although reference is made to a Japanese application No. 63-17521 on page 1 of the specification and a JP 63-17521 is supplied in an IDS in the parent application 09/452,731, the submitted JP 63-17521, titled "Carrying Method of Wafer Boat" appears to have no relationship to the subject matter attributed thereto in the instant specification.

***Claim Rejections - 35 USC § 102 and 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hara et al. (US 4,353,802):

6. Claims 1 and 4-6 are product-by-process claims. It is noted that "The Patent Office bears a lesser burden of proof in making a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" *In re Fessmann*, 180 USPQ 324, 326 (CCPA 1974).

7. Also, "the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on '*prima facie* obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same" *In re Fitzgerald* 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 195 USPQ 430, 433-434 (CCPA 1977)).

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8. "When the PTO shows a sound basis for believing the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not" *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

9. Regarding claims 1 and 6, Hara ('802) discloses a permeable composite reverse osmosis membrane comprising a thin film and a microporous structure to support the thin film (see abstract, lines 1-3); wherein the thin film is formed by reacting a polyvinyl alcohol based amine compound having at least two amino groups (see col. 4, line 33 to col. 10, line 22, especially formula I; Formula VIII; col. 22 lines 37 to col. 23 line 4; col. 26, lines 14-15; and col. 40, lines 32-65) with at least one substantially monomeric compound having at least two groups that react with the at least two amino groups on the polyvinyl alcohol based amine compound (see col. 29 line 21 to col. 30 line 19).

Testing under the conditions stipulated in claim 1 and 6 is not discussed by the reference. It is considered to be applicant's burden to prove that the membrane of Hara ('802) would not have the claimed properties (see *In re Fitzgerald, supra.*, *In re Best, supra.*, and *In re Spada, supra.*). It is alternatively considered that it would have been obvious to one of ordinary skill in the art to have made the membrane of Hara ('802) have the claim salt rejection and flux properties. Throughout the reference Hara ('802) discusses how to vary the salt rejection and flux properties of the membrane to be lesser or greater (see for example col. 13, lines 33-37; col. 27 lines 6-18; col. 28, lines 2-6; and col. 32, lines 30-36). As held in *In re Aller*, 105 USPQ 233,235 (CCPA 1955), "where the general conditions of the claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation". See

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also *In re Preda*, 159 USPQ 342, 344 (CCPA 1968). Regarding claim 4, the substantially monomeric compound is an acid chloride (see col. 29 line 21 to col. 30 line 19). Regarding claim 5, the substantially monomeric compound is at least one polyfunctional acid halide compound selected from the group consisting of aromatic, aliphatic, and alicyclic polyfunctional acid halide compounds (see col. 28 line 26 to col. 32 line 29).

10.

### ***Response to Arguments***

11. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



David Sorkin

January 24, 2003



W. L. WALKER  
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